



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

S.M.

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,755	07/24/2001	J. Michael Milliron	P02166US0	5349

26271 7590 11/14/2002
FULBRIGHT & JAWORSKI, LLP
1301 MCKINNEY
SUITE 5100
HOUSTON, TX 77010-3095

EXAMINER	
HENDERSON, MARK T	
ART UNIT	PAPER NUMBER

3722
DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary	Application No.	Applicant(s)	
	09/912,755	MILLIORN, J. MICHAEL	
	Examiner	Art Unit	
	Mark T Henderson	3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 September 2002.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-21, 23-33 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ . |

Art Unit: 3722

DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing of responses to Office Actions directly into the Group at (703)872-9302 (Official) and (703)872-9303 (for After Finals). This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claims 1, 14, 17 and 29 have been amended for further examination. Claim 22 has been canceled.

Art Unit: 3722

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. The term "easily" in claims 1, 14, 17 and 29 is a relative term which renders the claim indefinite. The term "easily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The degree of "easily" may be interpreted differently between two end users. A label being "easily lifted" or "easily removed" may be easy to one end user, but may be difficult to another. In arguendo, if applicant is disclosing the label as being "easily removed" or "easily lifted" so that the label is not destroyed when pulled upon or lifted, applicant must refer to the Sullivan et al in view of Kirk 103 rejection below.

Art Unit: 3722

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 6, and 14 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Kirk (6,332,631).

Kirk discloses in Fig. 2 and 3, a label (20) comprising: a first section (34 and 36), a second section which forms a tab portion (left side of 38 in Fig. 3) , wherein each section has a first (Fig. 3) and second side (Fig. 2); an adhesive layer adapted to easily releasably adhere the label to a substrate surface/ liner (Col. 5, lines 25-29 and Col. 6, lines 5-10); wherein the first side of the second section does not include an adhesive layer (Col. 6, lines 1-10); and wherein the second side of the label (Fig. 2) has a surface adapted to accept printing of text. As stated above in the 112 rejection the term “easily” is considered to be a relative term. What may be considered harder or more difficult to remove to one end user may be “easily removed” or “easily lifted” to another end user.

Art Unit: 3722

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 6 and 14 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Sullivan et al (5,172,936) in view of Kirk.

Sullivan et al discloses an adhesive label comprising a label (3 and 5) having an adhesive layer (13) adapted to releasably adhere the label to a substrate surface (container) and wherein the label is adapted to be easily removed from the substrate surface by lifting the tab portion (5) away from the substrate surface (Col. 4, lines 28-33).

However, Sullivan et al does not disclose: a first and second section wherein each section has opposite sides, and wherein the first side of the first section is contiguous with the first side of the second section; an adhesive layer confined to covering at least a portion of the first side of the first section; the second section forming a tab portion extending from an edge of the first section; and wherein the second side of the label has a surface adapted to accept printing of text.

Kirk discloses in Fig. 2 and 3, a label (20) comprising: a first section (34 and 36), a second section which forms a tab portion (left side of 38 in Fig. 3) , wherein each section has a first

Art Unit: 3722

(Fig. 3) and second side (Fig. 2); an adhesive layer adapted to easily releasably adhere the label to a substrate surface/ liner (Col. 5, lines 25-29 and Col. 6, lines 5-10); wherein the first side of the second section does not include an adhesive layer (Col. 6, lines 1-10); and wherein the second side of the label (Fig. 2) has a surface adapted to accept printing of text.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Sullivan et al's label by replacing the structure of the label to include a first and second section, and a tab portion extending from the edge of the first section, as taught by Kirk for the purpose of allowing an end user to removably adhere a label to view printed information on both side of the label.

6. Claims 2, 4, 5, 7-13 and 15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk.

Kirk discloses a label comprising all the elements as claimed in Claim 1, and as set forth above. However, Kirk does not disclose: the first section is in a particular shape; wherein the edge of the first section from which an edge of the second section extends converges with the edge of the second section to form a rounded edge between the first and second section; wherein the label, first and second sections are made of polypropylene; the text printed on the second side is related to food safety; wherein the second side surface accepts printing of color related to a color code system; wherein the adhesive is adapted to adhere to a substrate from a temperature range of about -10 degrees Celsius to 50 degrees Celsius.

Art Unit: 3722

In regards to **Claims 2 and 15**, it would have been an obvious matter of design choice to make the different portions of the first and second sections and portions of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claims 4 and 5**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the label out of any desirable material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claims 7-11**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

In regards to **Claims 12 and 13**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate an adhesive to adhere from any desirable temperature range, since it has been held that where the general conditions of a claim are

Art Unit: 3722

disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Claims 3, 16-21, 23-33 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Kirk in view of Sechet (5,472,756).

Kirk discloses a label comprising all the elements as claimed in Claim 1, and as set forth above. However, Kirk does not disclose: wherein an edge of the first section from which an edge of the second section extends converges with the edge of the second section to form a rounded edge between the first and second sections; wherein the label is fabricated; wherein the label is a plurality of labels; wherein the label liner is adapted to form a roll with labels;.

Sechet discloses a label comprising a first section (1, 2 and 3) from which an edge (A) of a second section (5) extends converges with the edge of the second section (B) to form an edge between first and second sections; and wherein the second section is non adhesive (Col. 4, lines 50-60); wherein the text on the label is related to food safety; .

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Kirk's label to include a first section having an edge which converges to an edge of the second section as taught by Sechet for the purpose of providing a means which to lift label section (1 and 2) from a substrate.

In regards to **Claims 3 and 16**, it would have been an obvious matter of design choice to make the different portions of the edge convergence of whatever form or shape was desired or

Art Unit: 3722

expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

In regards to **Claim 18**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the label in any desired material, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

In regards to **Claims 20 and 21**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate as many labels as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 24-28 and 30-33**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate any desirable indicia, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack* 217 USPQ 401, (CAFC 1983). Also, in the present case, there appears to be no new or unobvious structural relationship between the printed matter and the substrate.

Art Unit: 3722

Response to Arguments

8. Applicant's arguments filed on September 5, 2002 have been fully considered but they are not persuasive.

In regards to applicant's arguments that the Kirk reference does not teach having an adhesive layer adapted to releasably adhere the label to a substrate surface in which the entire label is adapted to be easily removed from a substrate surface, the examiner submits that the Kirk reference does indeed teach an adhesive layer that is releasably adhered to a substrate surface. The applicant must note that although the adhesive is "substantially permanent", the adhesive is still interpreted as "adapted to be releasably adhered" since it is not fully permanent. In regards to applicant's disclosure that the entire label is adapted to be "easily" removed, the examiner submits that the term "easily" is a relative term which renders the claim indefinite. The term "easily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The degree of "easily" may be interpreted differently between two end users. A label being "easily lifted" or "easily removed" may be easy to one end user, but may be difficult to another. If applicant wishes to state that the label is "easily" removed without destroying the adhesive surface, the examiner has also rejected the claims under a 103 rejection using Sullivan et al to disclose a label having an easily removable adhesive which will not destroy the label itself when removed.

Art Unit: 3722

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a label that is adapted to withstand extreme fluctuations in environmental conditions such as freezing and "backing") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

Art Unit: 3722

will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)-872-9302. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.

MTH

November 12, 2002


A. L. WELLINGTON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700